

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	Group Art Unit: 3611
Calvin Charles Shaw	§	
	§	Confirmation No.: 5649
Serial No.: 10/711,650	§	
	§	Examiner: Silbermann, Joanne
Filed: September 29, 2004	§	
	§	Attorney Docket No. 5404-04-1
Title: Method and Apparatus for Framing	§	
Greeting Cards	§	

SECOND AMENDED APPELLANT'S BRIEF (37 CFR § 41.37)

Mail Stop Appeal Brief-Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

A. INTRODUCTORY COMMENTS

This brief is submitted in response to the Notification of Non-Compliant Appeal Brief mailed on September 28, 2006 and in furtherance of the Notice of Appeal filed in this case on April 7, 2006.

B. REAL PARTIES IN INTEREST

The real party in interest in this appeal is Calvin Charles Shaw, an individual.

C. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

D. STATUS OF CLAIMS*1. Total number of claims in application*

The claims in the application are: 1-20

2. Status of all claims in application

- Claims canceled: None
- Claims withdrawn from consideration but not canceled: None
- Claims pending: 1-20
- Claims allowed: None
- Claims rejected: 1-20

3. Claims on appeal

The claims on appeal are: 1-20

E. STATUS OF AMENDMENTS

All amendments have been entered in this case.

F. SUMMARY OF INDEPENDENT CLAIMS ON APPEAL

Independent claim 1 recites a method of framing a work, comprising:

threading the work (reference character 402 in Figure 4) through a plurality of slits (reference characters 304 and 305 in Figure 3) in a sheet of material (reference character 302 in Figure 3, which makes up part of reference character 300), wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits (Page 6, Para. 25; Fig. 4);

positioning the sheet of material within a picture frame (Page 7, Para. 28; Fig. 7); and

attaching a backing (reference character 500 in Figures 5-7; Page 5, Para. 26) behind the sheet of material (Page 7, Para. 28; Fig. 7).

Independent claim 11 recites an apparatus for framing a work, comprising:

a picture frame (reference character 100 in Figures 1, 6, and 7; Page 4, Para 18);

a first mat (reference character 200 in Figures 2A, 2B, and 7), wherein the first mat contains an opening that is sized to allow the work to be viewed through the opening (Page 4, Para 20);

a second mat (reference character 300 in Figures 3 and 7), wherein the second mat contains a plurality of slits (reference characters 304 and 305 in Figure 3) that are sized and positioned to allow the work (reference character 402 in Figure 4) to be held into place upon the second mat by threading the work through the slits, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits (Page 6, Para. 25; Fig. 4); and

a mount board (reference character 500 in Figures 5-7; Page 5, Para. 26) that is positioned relative to the picture frame, first mat, and second mat so as to enclose the first mat and second mat between the picture frame and mount board (Page 7, Para. 28; Fig. 7).

G. ISSUES

1. Whether claims 1-3 and 9-12 are obvious under 35 U.S.C. § 103 in view of US 4,391,053 (*Anthony*) and US 4,849,056 (*Ristuccia*).
2. Whether claims 4-8 and 13-20 are obvious under 35 U.S.C. § 103 in view of US 4,391,053 (*Anthony*), US 4,849,056 (*Ristuccia*), and US 5,524,373 (*Plumly*).

H. ARGUMENT

Issue 1: 35 U.S.C. § 103, Obviousness, claims 1-3 and 9-12

The Examiner has rejected claims 1-3 and 9-12 under 35 U.S.C. § 103 as being unpatentable over US 4,391,053 (*Anthony*) in view of US 4,849,056 (*Ristuccia*). The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The Examiner has failed to meet that burden for the following reasons.

A. Claims 1 and 11

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In support of her rejection of the independent claims, claims 1 and 11, the Examiner asserts that one skilled in the art would be motivated to combine the vertical slits used in the business card file disclosed in *Ristuccia* (see Figure 3 of *Ristuccia*) with a picture frame and mat, as described in *Anthony*, “so as to provide a more secure holding means for the work.” (Final

Office Action at 2). This is not a proper motivation to combine the references, however, because the cards in the *Ristuccia* business card file, which are vertical, do not, in fact, provide a more secure holding means for the work than does the photo frame in *Anthony*. As shown in Figure 9 of *Anthony*, *Anthony* uses a backing plate (reference 40) containing **diagonal slits**, which are positioned at opposing corners of the photos being framed (references 80 and 81, for example). See *Anthony*, col. 4, lines 44-60. The *Anthony* device holds photos in such a way that they cannot be moved horizontally or vertically, so that they will remain properly aligned with the mat when the frame is assembled.

Ristuccia's device, which is used for holding business cards in a removable fashion, only restrains a business card vertically. If one applies a lateral (side-to-side) force to a business card mounted in the *Ristuccia* device from side to side, the card will easily move or even slide out of its mounting slits. (see Figures 5A-5D of *Ristuccia*). This allows one to easily remove or reposition the card for easy reading of the information printed on the card (for example, if information printed at the edge of the card is partially obscured from view when mounted in the card file).

However, while this ability to easily reposition a business card in the *Ristuccia* card file is a beneficial feature to the application *Ristuccia* is designed for (namely, maintaining a file of business cards), it is, in fact, detrimental to the application *Anthony* is designed for (displaying photographs in a vehicle-mounted picture frame). What is more, modifying *Anthony* to use vertical slits instead of diagonal corner slits would actually defeat the purpose of the diagonal slits in the first place, which is to maintain constant two-dimensional alignment of framed photographs in a moving vehicle.

Further, neither *Anthony* nor *Ristuccia* are directed to the problem solved by the present by the present invention, which is that of framing an item so that it can easily be

Therefore, the motivation to combine these two references proposed by the Examiner simply does not exist.

B. Claims 2-3, 9-10, and 12

Claims 2-3, 9-10, and 12, having dependency on claims 1 and 11 are patentable for the same reasons set forth with respect to claims 1 and 11.

Issue 2: 35 U.S.C. § 103, Obviousness, claims 4-8 and 13-20

The Examiner has rejected claims 4-8 and 13-20 under 35 U.S.C. § 103 as being unpatentable over US 4,391,053 (*Anthony*) in view of US 4,849,056 (*Ristuccia*) and US 5,524,373 (*Plumly*).

A. Claims 8 and 18

For an invention to be prima facie obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). **Appellants respectfully submit that claims 8 and 18 were improperly rejected as the references neither teach nor suggest all of the elements of these claims.**

With regard to claims 8 and 18, the references fail to teach or suggest all elements of these claims. Claim 8 includes the limitation of attaching a magnetic surface to an envelope associated with the work and magnetically affixing the envelope associated with the work to the sheet of material.¹ Claim 18 includes the limitation of a first detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an envelope associated with the work.² These limitations are neither taught nor suggested by the cited references.

In fact, neither of these limitations was addressed by the Examiner at all in either of the two Office Actions entered in this case (*i.e.*, the November 7, 2005 Office Action and the February 2, 2006 Final Office Action). The Examiner’s rejection in view of *Anthony*, *Ristuccia*, and *Plumly* fails to address claims 8 and 18 individually and fails to identify any teaching or suggestion of attaching an *envelope associated with a framed work* using a magnetic surface or other detachable attachment surface. While the Examiner notes that the *Plumly* reference discusses the use of magnetic surfaces to frame an advertisement using a mat, the Examiner did not argue that *Plumly* or any other cited reference teaches or suggests the additional use of magnetic surfaces to attach additional items associated with a framed work, such as an envelope.

¹ Specifically, claim 7 recites “attaching a magnetic surface to an item associated with the work; and magnetically affixing the item to the sheet of material,” and claim 8 recites “The method of claim 7, wherein the item is an envelope.”

² Specifically, claim 16 recites “a detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an item associated with the work,” and claim 18 recites “The apparatus of claim 16, wherein the item is an envelope.”

Moreover, none of the three cited references contains any teaching or suggestion relating to the use of detachable attachment surfaces or magnetic surfaces to attach an envelope associated with a framed work. In fact, the word “envelope” does not even appear in any of the three cited references.

For these reasons, Applicant respectfully submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness with respect to claims 8 and 18. Therefore, the rejection of those claims should be reversed.

B. Claims 4-7, 13-17, and 19-20

Claims 2-3, 9-10, and 12, having dependency on claims 1 and 11 are patentable over *Anthony* and *Ristuccia* for the same reasons set forth with respect to claims 1 and 11, above. The additional *Plumly* reference cited with respect to dependent claims 4-7, 13-17, and 19-20 fails to cure the deficiencies of *Anthony* and *Ristuccia* with respect to claims 1 and 11. Specifically, *Plumly* does not teach or suggest threading a work to framed through vertical slits, nor does *Plumly* provide any incentive or motivation to modify the teachings of *Anthony* and *Ristuccia* to include such a feature. Therefore, dependent claims 4-7, 13-17, and 19-20 are patentable over the cited references.

Date: June 25, 2007

Respectfully submitted,

By /Michael R. Nichols/
Michael R. Nichols
Attorney for Appellant
Registration No. 46,959
Telephone: (972) 369-1300
Facsimile: (469) 519-0144

I. APPENDIX OF CLAIMS

Claim 1 (previously presented): A method of framing a work, comprising:

threading the work through a plurality of slits in a sheet of material, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits;

positioning the sheet of material within a picture frame; and

attaching a backing behind the sheet of material.

Claim 2 (original): The method of claim 1, further comprising:

positioning a mat within the picture frame such that the work is exposed through an opening in the mat.

Claim 3 (original): The method of claim 2, further comprising:

affixing the mat to the picture frame with mounting points.

Claim 4 (original): The method of claim 3, wherein at least a portion of a surface of the mat is covered in a magnetic material.

Claim 5 (original): The method of claim 4, wherein at least a portion of the sheet of material is covered in a magnetic material and wherein positioning the sheet of material within the picture frame includes magnetically affixing the sheet of material to the mat.

Claim 6 (original): The method of claim 5, wherein the backing comprises a mount board, wherein at least a portion of a surface of the mount board is covered in a magnetic material, and wherein attaching the backing includes magnetically affixing the mount board to the sheet of material.

Claim 7 (original): The method of claim 5, further comprising:

attaching a magnetic surface to an item associated with the work; and magnetically affixing the item to the sheet of material.

Claim 8 (original): The method of claim 7, wherein the item is an envelope.

Claim 9 (original): The method of claim 1, wherein the work is a document.

Claim 10 (original): The method of claim 9, wherein the document is a greeting card.

Claim 11 (previously presented): An apparatus for framing a work, comprising:

- a picture frame;

- a first mat, wherein the first mat contains an opening that is sized to allow the work to be viewed through the opening;

- a second mat, wherein the second mat contains a plurality of slits that are sized and positioned to allow the work to be held into place upon the second mat by threading the work through the slits, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits; and

- a mount board that is positioned relative to the picture frame, first mat, and second mat so as to enclose the first mat and second mat between the picture frame and mount board.

Claim 12 (original): The apparatus of claim 11, wherein the first mat is held into the picture frame with a plurality of mounting points.

Claim 13 (original): The apparatus of claim 12, wherein the first mat, second mat, and mount board each include detachable attachment surfaces and wherein the first mat, second mat, and mount board are attached to each other in a layered configuration in which the detachable attachment surfaces hold the first mat, second mat, and mount board together in the layered configuration.

Claim 14 (original): The apparatus of claim 13, wherein the detachable attachment surfaces are magnetic surfaces.

Claim 15 (original): The apparatus of claim 13, further comprising:

- a ribbon attached to the mount board, wherein the mount board may be detached from the second mat by pulling the ribbon.

Claim 16 (previously presented): The apparatus of claim 11, wherein the first mat, the second mat, or the mount board includes a first detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an item associated with the work.

Claim 17 (original): The apparatus of claim 16, wherein the first detachable attachment surface and second detachable attachment surface are magnetic surfaces.

Claim 18 (original): The apparatus of claim 16, wherein the item is an envelope.

Claim 19 (original): The apparatus of claim 11, wherein the work is a document.

Claim 20 (original): The apparatus of claim 19, wherein the document is a greeting card.

J. APPENDIX OF EVIDENCE SUBMITTED UNDER 37 CFR 1.130, 1.131, OR 1.132

None.

K. APPENDIX OF DECISIONS IN RELATED PROCEEDINGS

None.